

Application No. 10/630,292
Amendment dated December 20, 2005
Reply to Office Action of October 12, 2005

REMARKS

Status Of Application

Claims 3, 9-13, 16, 17, and 19-39 are pending in the application; the status of the claims is as follows:

Claims 11-13, 16, 17, 19, 25-29 and 38 are allowed.

Claims 3, 9, 10, 20, 31-34 and 39 are rejected.

Claims 21-24, 30 and 35-37 are objected to.

Information Disclosure Statement

The indication, in the Office Action, that the Examiner acknowledged receipt of the PTO Forms 1449, is noted with appreciation.

Claim Amendments

Claim 20 has been amended to clarify a limitation previously included in the claim. This change is not necessitated by the prior art, is unrelated to the patentability of the invention over the prior art, and does not introduce any new matter.

Claim 24 has been amended to include the limitations of claim 3, which has been cancelled in this amendment.

Claims 3 and 39 have been cancelled.

Allowable Subject Matter

The allowance of claims 11-13, 16, 17, 19, 25-29, and 38, by the Examiner, is noted with appreciation.

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The objection to claims 21-24, 30, and 35-37 as being dependent upon a rejected base claim, but allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims, is noted with appreciation.

Claim 24 has been amended to include the limitations of claim 3, which has been cancelled in this amendment.

However, claims 21-23, 30, and 35-37 have not been rewritten in independent form because contrary to the Office Action, Applicant believes that the respective independent base claims are allowable.

No New Matter

This Amendment is being presented promptly after the discovery of the need therefor. This Amendment does not affect the scope of the claims, does not introduce any new matter, does not present any new issue, does not require any additional search, and will not present an undue burden on the personnel of the Patent and Trademark Office. Accordingly, it is respectfully requested that the Amendment be entered in accordance with 37 C.F.R. § 1.312.

35 U.S.C. § 112 Rejection

The rejection of claim 39 under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention, has been rendered moot by Applicant's election to cancel that claim.

35 U.S.C. § 102(b) Rejection

The rejection of claims 3, 9, 10, 20, 31-34, and 39 under 35 U.S.C. § 102(b) as being anticipated by the U.S. Patent No. 5,758,725 to Streetman ("Streetman"), is respectfully traversed based on the following.

As to claims 3 and 39, those claims have been cancelled, rendering the rejection moot.

As to claims 9 and 10, it is believed that Applicant's earlier response regarding these claims dated August 26, 2005 was somewhat unintentionally unclear, and that the Examiner has therefore misunderstood Applicant's argument. Applicant had earlier argued that Streetman fails to disclose the "interface section" claimed in claim 9 (as claim 10 depends from claim 9, all arguments herein will refer only to claim 9, but should be understood as applying to claim 10 as well), and that, therefore, Streetman does not anticipate claim 9. In connection with this argument, Applicant mistakenly referenced element 59 of Streetman and argued that this element does not satisfy the "interface section" element required by claim 9. However, element 59 of Streetman describes the "retention fingers" used by Streetman to retain the chemical stick in the plunger and are in no way related to the "interface section" claimed in the present application and therefore, the Examiner's rejection of Applicant's unintentional misstatement was misguided. The present specification makes it clear that the "interface section" is a section of the plunger that interfaces with the inside of the well tubing, not a means for interfacing with the treatment chemical. For example, as shown in the specification, paragraphs 22 and 34 and figures 2A – 2D, the interface section is element 62 of the plunger, and is generally a section of the plunger that provides mechanical cleaning of the inside of the tubing via means such as a brush, helical grooves, or pads, although the interface section need not be limited to this function. Conversely, there is no apparent function to the plunger disclosed by Streetman other than as a weight to deliver a treatment stick down the well and there is no indication that the plunger of Streetman is designed to interface with the tubing string in any way. Thus, once Applicant's argument regarding claims 9 and 10 is more correctly stated and more fully understood, it is apparent that Streetman does not disclose the claimed interface section, and that claims 9 and 10 are not anticipated by Streetman.

As to claim 20, Applicant has amended the claim to positively set forth a tubing stop through which the claimed receptacle may pass. Thus, as Applicant has previously argued, Streetman does not disclose the aspect of being able to deliver a chemical receptacle beyond the tubing stop. Specifically, it should be noted that the present claim

requires that the receptacle for receiving a treatment chemical be able to pass through the tubing stop, not merely that the chemical pass through the tubing stop. This is in direct contrast to Streetman which, in the Examiner's view, discloses only that a chemical stick be able to pass through the tubing stop. This difference is important because the present invention discloses the use of different physical forms of treatment chemical such as capsules, gels, pastes, putties, liquids, emulsions, etc. Because these physical forms do not take on a generally rigid shape, they must be placed in a receptacle of some type in order to be efficiently delivered to the bottom of a well. Claim 20 requires that this receptacle be dimensioned so as to fit through a tubing stop in order to deliver chemicals to the wellbore below the tubing. Because Streetman discloses only the use of a chemical treatment stick, a rigid physical form not requiring a receptacle, it does not disclose a receptacle at all, much less one of a particular dimension. Thus, the inclusion of a particularly dimensioned receptacle serves to distinguish claim 20, and claim 20 is not anticipated by Streetman.

As to claims 31-34, claims 31 and 32 both ultimately depend from claim 9, which Applicant has traversed. Claim 33 depends from claim 19 which the Examiner has indicated is in condition suitable for allowance, thus the Applicant believes the Examiner's rejection of claim 33 is in error. Finally, claim 34 depends from claim 20 which Applicant has also traversed. Therefore, Applicant believes that each of claims 31-34 is not anticipated by Streetman and is in condition for allowance.

Accordingly, it is respectfully requested that the rejection of claims 3, 9, 10, 20, 31-34, and 39 under 35 U.S.C. § 102(b) as being anticipated by the U.S. Patent No. 5,758,725 to Streetman ("Streetman"), be reconsidered and withdrawn.

CONCLUSION

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims.

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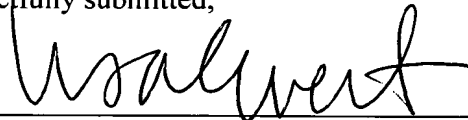
Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Hitchcock Evert LLP's Deposit Account No. 503374.

Any fee required by this document other than the issue fee, and not submitted herewith should be charged to Hitchcock Evert LLP's Deposit Account No. 503374. Any refund should be credited to the same account.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Hitchcock Evert LLP's Deposit Account No. 503374. Any refund should be credited to the same account.

Respectfully submitted,

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